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10/805,038	03/19/2004	Eugene August Fusz	10209-00007CIP	7961

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EXAMINER
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BOYCE, ANDRE D

ART UNIT	PAPER NUMBER
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3623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/805,038	<b>Applicant(s)</b> FUSZ, EUGENE AUGUST	
	<b>Examiner</b> Andre Boyce	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 6-11 and 34-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of invention II, claims 12-33, in the reply filed on April 22, 2009 is acknowledged. The traversal is on the ground(s) that the inventions set out by the claims in each of the groupings are clearly related. The relatedness of the claims, and the position that the claims describe a single invention, is further shown by the fact that all three of the claim groupings are described as being within the same class and subclass (class 705, subclass 10). Applicant submits that a thorough search and examination of any of the claim groupings would be relevant to the examination of the other claim groupings and would not be a serious burden on the Examiner. In addition, Applicant argues the Examiner never sets forth how the claim groups are separately usable. Instead, the Office Action merely quotes the claim language of each independent claim of the application.

This is not found persuasive. First, as discussed in MPEP §808.02, "... (C) A different field of search: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes /subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search" (emphasis added). Here, inventions I, II and III indeed

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require a different field of search, as evidenced by the subcombinations. Second, and contrary to Applicant's assertion, the claim language itself indeed provides examples of the inventions being separately usable, as discussed in the restriction requirement. Moreover, the Examiner is not aware of any passage in the MPEP prohibiting the use of the claim language to support a restriction requirement. As a result, the requirement is still deemed proper and is therefore made FINAL.

2. Claims 1, 6-8 and 34 have been amended. Claim 5 has been canceled. Claims 1-4 and 6-38 are pending. Claims 1-4, 6-11 and 34-38 have been withdrawn, while claims 12-33 have been examined.

### ***Claim Objections***

3. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12-14 and 16-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to independent claim 12 the claim language recites the steps of (a) providing a questionnaire to a consumer, the questions having a nature such that answers to the questions include only non-identifying information concerning the consumer; (b) accepting answers to the questionnaire, the answers containing only non-identifying information; (c) configuring the received answers as a consumer profile database, etc., however the claim language does not include the required tie or transformation.

Claims 13, 14 and 16-23 are rejected based upon the same rationale, wherein the claim language does not include the required tie or transformation.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 12-21 and 23-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldhaber et al (USPN 5,855,008).

As per claim 12, Goldhaber et al disclose a method for generating a database of personalized anonymous consumer profiles (i.e., private profiles of consumer interests, column 6, lines 40-49), said method comprising: (a) providing a questionnaire to a consumer, the questions having a nature such that answers to the questions include only non-identifying information concerning the consumer (i.e., profile questionnaire requesting certain demographic related information, column 13, lines 32-35); (b) accepting answers to the questionnaire, the answers containing only non-identifying information (i.e., consumer asked to provide interest profile information, column 13, lines 30-31); (c) configuring the received answers as a consumer profile database (i.e., database 120, figure 7); (d) providing advertisements to the consumer based on the consumer profile database (i.e., use of consumer interest profile to target advertisements, column 14, lines 22-25); (e) receiving feedback on the advertisements (i.e., feedback, column 18, lines 57-59); (f) updating the consumer profile database based on the feedback (i.e., feedback used to fine-tune the consumer's interest profile, column 18, lines 59-61); and (g) repeating steps (d) through (f) (i.e., consumer selects a plurality of ads, column 18, lines 49-67).

As per claim 13, Goldhaber et al disclose providing updated questions to the consumer based on one or more of the received answers and the received feedback

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(i.e., the ad display may ask the consumer questions, column 16, lines 16-23); receiving answers related to the updated questions (i.e., successful completion of the process); and updating the consumer profile based on the answers received relating to the updated questions (i.e., feedback used to fine-tune the consumer's interest profile, column 18, lines 59-61 and figure 13).

As per claim 14, Goldhaber et al disclose compensating the consumer for at least one of the received answers to the questionnaire (i.e., ad display asks the consumer questions, column 16, lines 16-23), the received answers to the updated questions, and the feedback received on the advertisements.

As per claim 15, Goldhaber et al disclose instructing the consumer to access a randomly generated website to download the compensation (i.e., consumer clicks her mouse onto the CyberCoin icon, column 11, lines 11-19).

As per claim 16, Goldhaber et al disclose answering questions regarding appropriateness (i.e., use of consumer interest profile to target advertisements, column 14, lines 22-25, wherein the consumer indicates whether they liked or disliked the ad, column 18, lines 57-61) and timing of the advertisements.

As per claim 17, Goldhaber et al disclose storing the consumer profiles in a database (i.e., database 120, figure 7).

As per claim 18, Goldhaber et al disclose accessing the database to provide updated answers to previously answered questions (i.e., update your profile at any time, column 13, lines 45-51).

As per claim 19, Goldhaber et al disclose selecting a purchase option for an item within an advertisement (i.e., consumer may place an order for goods in response to interaction with an ad, column 18, lines 54-57); and updating the profile to include that the item has been purchased (i.e., feedback used to fine-tune the consumer's interest profile, column 18, lines 59-61 and figure 13).

As per claim 20, Goldhaber et al disclose the anonymous profiles are maintained by an intermediary, and wherein advertisers pay the intermediary to provide advertisements to the consumers based on the anonymous consumer profiles (i.e., attention broker 106, column 14, lines 30-34, wherein a financial clearinghouse may act as the attention broker, column 10, lines 1-8).

As per claim 21, Goldhaber et al disclose the intermediary distributes a portion of the pay to the consumers who provide feedback on the advertisements (i.e., consumer computer interacts with financial clearinghouse, column 10, lines 1-8).

As per claim 23, Goldhaber et al disclose presenting the questionnaire to the user in a non-text entry format including one or more of true/false selections, pull down menus (i.e., selection of female/male, column 13, lines 60-62), and multiple choice selections.

As per claim 24, Goldhaber et al disclose logging into a computer storing the database utilizing at least one of an anonymizing program, a random username (i.e., handle, column 13, lines 15-16), and answering a series of previously answered questions to uniquely identify a user to the computer.



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Claims 25-32 are rejected based upon the same rationale as the rejections of claims 12-15, 17, 23, 24 and 24, respectively, since they are the system claims corresponding to the method claims.

As per claim 33, Goldhaber et al disclose the non-identifying questions are personal in nature (i.e., profile questionnaire requesting certain demographic related information, column 13, lines 32-35).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (USPN 5,855,008), in view of Kepecs (USPN 6,009,411).

As per claim 22, Goldhaber et al does not explicitly disclose providing an inability to accept identifying information. Kepecs discloses a method of distributing and redeeming promotions wherein no consumer identification is maintained (see column 2, lines 50-52). The lowest level of identification in Kepecs is simply a unique customer key with no other identification data (see column 6, lines 51-53), wherein the consumer is compensated via a discount or credit (see column 5, lines 41-45), identified via the key (see column 5, lines 55-57). Both Goldhaber and Kepecs are

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concerned with an effective method of marketing products to potential consumers, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include maintaining the anonymity of the individual through an inability to accept contact information in the profile in Goldhaber et al, as seen in Kepecs, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Dedrick (USPN 5717923) discloses a method and apparatus for dynamically customizing electronic information.

-Babcock, Jr. (USPN 6249790) discloses a method of operating a database of records.

-O'Flaherty et al (USPN 6253203) disclose storing and retrieving data in a database implementing privacy control.

-Solomon et al (USPN 4847890) disclose establishing telephone communications between subscribers and callers.

-Walker et al (USPN 5884272) disclose establishing anonymous communications.

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-Gabber et al (USPN 5961593) disclose a user able to browse server sites anonymously via a proxy system.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571)272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andre Boyce/  
Primary Examiner, Art Unit 3623  
August 2, 2009